because the patented claims also recite a cosmetic composition, which is similar in scope of the instant claims." Office Action of March 4, 2002 at page 2. The Office also asserted that claims 1-31 are directed to an invention not patentably distinct from claims 1-47 of Mougin. The Office alleged that "both the patented claims and instant claims recite a cosmetic composition comprising at least one fatty substance and a non-aqueous dispersion of surface-stabilized polymer particles in at least one liquid fatty substance, wherein the polymer particles being [sic] surface stabilized by surface-stabilized polymer." Id. at page 3.

In determining whether a nonstatutory basis for a double patenting rejection exists, the Office determines if any claim in the present application defines an obvious variation of a claimed invention. *See M.P.E.P.* § 804(B)(1). If not, then an obviousness-type nonstatutory double patenting rejection is inappropriate. *See id.*

Analyzing an obviousness-type double patenting rejection parallels that of a 35 U.S.C. § 103(a) obviousness rejection. *See id.* The analysis of an obviousness-type double patenting rejection, however, focuses on the claims of each application. *See id.* Indeed, the obviousness-type double patenting rejection should clearly state both (a) the differences between the claimed invention of the present application and the patented invention that form the basis of the rejection and (b) why a person of ordinary skill in the art would conclude that the invention of the present claims is an obvious variation of the invention of the patented claims. *See id.* Otherwise, the rejection would be improper.

Such is the case here. On one hand, each current version of the claims of this application recite limitations regarding the weight percentages of the polymer and the

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viscosity of the composition . On the other hand, each current version of the claims in Mougin fail to recite an analogous limitation. Since silence cannot equal a reason why a person of ordinary skill in the art would conclude that the invention of present claims is an obvious variation of the invention of a claim in Mougin, the rejection is improper.

III. Rejection under 35 U.S.C. § 103(a)

The Office also rejected claims 1-31 under 35 U.S.C. § 103(a) as being unpatentable over claims 1-47 of Mougin for the reasons set forth on pages 5 and 6 of the Office Action dated March 4, 2002. As acknowledged by the Office, Mougin does not specifically mention the weight percentages of the polymer or the viscosity of the disclosed composition, as recited in the present claims.

To establish a prima facie case of obviousness, three basic criteria must be met. These criteria include that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See* M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination must both be found in the prior art, not in Applicants' disclosure. *See In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that the Office has failed to set forth, with the degree of specificity required by the Federal Circuit, the motivation needed to make the selections and modifications in the compositions of Mougin, as well as any of its foreign counterparts, in an attempt to arrive at the claimed invention. In fact, Applicants submit that such guidance is not present to suggest, for example, the selection of an amount of polymer that is within the weight percentages recited in the claim. *Cf. M.P.E.P.*

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§ 2143.01. Accordingly, the compositions disclosed in Mougin fail to suggest the presently claimed invnention.

Further to Examiner's comments at page 5 of the outstanding Office Action, Applicants additionally state that Mougin and the present application were, at the time the invention was made, owned by, or subject to an obligation of assignment to the same entity, L'Oréal.

IV. Rejection Under 35 U.S.C. § 102(b)

The Office also rejected claims 1-31 under 35 U.S.C. § 102(b) as being anticipated by EP 749 747. The Examiner stated that the "English equivalent of EP 749 747 is U.S. [Patent No.] 5,851,517, since both EP and U.S. patents claim priority over the same French Application. Therefore, the teachings of [the] U.S. reference are relied upon." Office Action of March 4, 2002 at page 6.

As an initial matter, Applicants are puzzled by the use of obviousness language in the penultimate line of page 6 of the Office Action since the Office made an anticipation rejection. Clarification is therefore respectfully requested. In order to advance prosecution, however, Applicants traverse the rejection under §102(b) for at least the following reasons.

The Office alleged that EP 749 747 "teaches a composition containing a dispersion of surface stabilized polymer particles in a non-aqueous medium. EP suggests using polymers such as those used in nail polish and mascara...." *Id.* The Office admits, however, that EP 749 747 "fails to teach the viscosity of the composition, as claimed in the instant [invention]." *Id.*

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Applicants respectfully traverse this rejection. A claim is anticipated only if each and every element as set forth in the claim is taught, either expressly or inherently, in a single prior art reference. See *M.P.E.P. § 2131*. The reference must "sufficiently describe the claimed invention to have placed the public in possession of it." *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1572, 24 U.S.P.Q.2d 1321, 1332 (Fed. Cir. 1992).

Because the Office admitted that EP 749 747 fails to teach the viscosity of its composition, the only way the compositions of this reference could anticipate the claimed invention would be if these compositions inherently possessed the claimed viscosity. However, Applicants are not aware of any evidence showing that the compositions of EP 749 747 inherently possess the claimed viscosity value; rather, the reference itself shows that the viscosity varies greatly.

Indeed, the Office stated that EP 749 747 "teaches various formulations such as gels, milky dispersions, and oils, etc, which are different in their viscosities." *See* Office Action of March 4, 2002 at page 6. This statement supports Applicants' position that the compositions of the references, which have differing viscosities, would not necessarily and inevitably possess the claimed viscosity value. Therefore, each and every element as set forth in the claims of the present invention is not expressly described, and would not be inherently described by EP 749 747, and the rejection should be withdrawn for this reason alone.

Additionally, EP 749 747 fails to disclose a composition containing at least 2% by weight polymer particles, as is claimed. Thus, the claimed minimal amount of polymer particles, as well as viscosity, are not disclosed by this reference. This is another

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element, as set forth in the claims of the present invention, that is neither expressly nor inherently described by EP 749 747, and the rejection should be withdrawn for this reason as well.

V. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: June 4, 2002

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